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AUZVILLE JACKSON, JR. 8652 RIO GRANDE ROAD RICHMOND, VA 23229			RHODE JR, ROBERT E	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 6/28/2004

Application Number: 09/690,055
Filing Date: August 31, 2000
Appellant(s): William R. BRISEL

MAILED

AUG 25 2004

GROUP 3600

Auzville Jackson, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 4, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The grouping of the claims in the brief is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,970,475	Barnes et al	10-1999
6,023,683	Johnson et al	2-2000
6,418,416 B1	Rosenberg et al	7-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: This rejection is set forth in Final Office Action, paper number 20040211.

(11) Response to Arguments

The appellant has one Grouping for the claims and focuses their arguments accordingly on independent claim 6.

Appellant remarks at pages 4, 5, 6 and 7 of the brief that the applied reference (Barnes) in this 35 USC 103(a) rejection does not teach every element of claim 6. In that regard, the appellant specifically argues that Barnes does not teach, "allowing multiple vendors to download their catalog information to the buyer's server for initial loading as well as updates". Additionally the appellant argues that Barnes does not teach "a buyer's server for storing and searching on site inventory" nor does the reference teach "integration with other company electronic files".

First, Barnes in combination with Rosenberg discloses and teaches all the limitations of Claim 6. The references in combination disclose and teach a method and system for an automated requisitioning and inventory system. In that regard, Barnes, which is the base reference did disclose an automated requisition system (i.e. eProcurement) with a program in a server (ESAC) that operates on a secure company intranet wherein the program can be accessed by authorized employees at one or more terminals (see at least Col 7, lines 48 – 59 and Figures 2, 3 and 14); storing vendor catalog information in the ESAC (see at least Col 2, lines 44 – 54, Col 9, lines 25 – 29 and Figures 4 and 14); allowing multiple vendors to download their catalog information to the ESAC for initial loading of their catalogs or updating of their catalogs (see at least Col 2, lines 44 – 47, Col 9, lines 25 – 29 and Figures 2 – 4 and 14). Moreover, Barnes refers to and provides a brief analysis of the King Patent (US 5,319,542), which specifically states, "the disclosure is primarily concerned with establishing a private catalog resident on a customer's computer system" (Col 2, lines 44 – 47). In online eProcurement methods and systems as taught by Barnes and known to one of ordinary

skill, there are various systems of storing and searching approved suppliers' catalogs such as allowing the user to punch out via their internal server to the supplier's catalog server or have the supplier download their catalog to the organization's internal server. Moreover and as commonly known in online eProcurement, the system design using either approach has pluses and minuses - with the selection of an approach dependent upon business requirements. For example, allowing a vendor to download their catalog to an internal server provides more control for the organization of the content of the catalogs while lessening extraneous purchasing of other items. Thereby, Barnes would fairly suggest and teach one of ordinary skill that there are several proven methods and systems for catalog storage and maintenance, which include vendors downloading, storing and updating their catalogs on a customer's server (ESAC). Furthermore, the express, implicit and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103 (MPEP 2112). Therefore, Barnes in light of its King Patent analysis discloses and teaches one of ordinary skill in the art of "allowing multiple vendors to download their catalog information to the ESAC for initial loading of their catalogs or updating of their catalogs" (Abstract, Col 2, lines 44 - 58, Col 9, lines 25 - 29 and Figure 1).

Second and regarding appellant arguments (pages 6 and 7 of the brief) for "searching on site inventory", Barnes does disclose searching (Col 2, line 66 and Col 8, lines 36 - 37). In addition, Barnes discloses a system capability of integration with any potential legacy system (Col 7, lines 60 - 67 and Col 8, lines 1 and 36 - 37, Col 10, lines 18 - 22 and Figure 6B). In that regard, inventory of items on-site would be a key legacy

system of any for-profit business. Moreover, it is well known to one of ordinary skill in the art that common business practice and operating procedures in any for-profit business is to check by searching the availability of on-site items. In that regard, Barnes would fairly suggest and teach one of ordinary skill of storing and searching of on-site inventory while concurrently searching online suppliers catalogs - since the systems are integrated. As noted by the appellant, it was inadvertently indicated in the Final Rejection at page 3 that Barnes taught this limitation of searching on-site items. However, and as noted in the Final Rejection at page 4, Barnes did not specifically disclose a system for storing and searching on-site inventory information. On the other hand, Rosenberg (an online inventory system) discloses and teaches a system for storing and searching on – site items information (see at least Abstract). Furthermore and as noted in the Final Rejection at page 7, Rosenberg does teach a method and system for storing on-site inventory information in a server with a program (see at least Abstract, Col 2, line 36 and Figures 1 and 2). Thereby, the references in combination would fairly suggest and teach to one of ordinary skill in the art for an automated acquisition and inventory system with the ability to store and search of on-site items as well as concurrently searching the items in approved vendors' catalogs. In this manner, the business is assured of staying profitable by ensuring control of the on site inventory of items, which is important for cost control and thereby profitability.

Third and regarding appellant's remarks at page 5 of the brief relative to "integration with other company electronic files". Barnes would fairly suggest and teach providing the capability to integrate with any legacy system (Col 9, lines 15 – 59 and

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Figures 6A and B). Therefore, the reference discloses and teaches to one of ordinary skill in the art integrating ESAC functions with other company electronic files so that budgeting, accounting and authorization limitations are implemented in the purchasing process and tracking of purchases is possible (see at least Col 8, lines 28 – 57, Col 9, lines 5 - 59 and Figures 3 and 5).

Appellant remarks at pages 7 and 8 of the brief that the applied references of Barnes, Rosenberg and Johnson do not individually teach all the claim limitations of 1 or 6.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Of note, Johnson was not relied upon nor was it required to teach the limitations in claim 6. Appellant's arguments regarding Barnes and Rosenberg references are addressed above.

Appellant remarks at pages 9 - 11 of the brief that the Examiner did not identify a valid suggestion to combine Barnes and Rosenberg as well as the combination of Barnes and Rosenberg with Johnson.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Barnes and Rosenberg disclose and teach all the limitations of claim 6. Specifically, Barnes discloses an automated acquisition system with storing, searching and purchasing a wide variety of items from an intranet based electronic stockroom and catalog (ESAC) comprising: an ESAC program that is executed on a server that operates on a secure company intranet wherein the ESAC can be accessed by authorized employees at one or more terminals; storing vendor catalog information in the ESAC; allowing multiple vendors to download their catalog information to the ESAC for initial loading of their catalogs or updating of their catalogs; providing search capabilities for simultaneous searching, by authorized employees, of the multiple vendor catalogs; integrating ESAC functions with other company electronic files so that budgeting, accounting and authorization limitations are implemented in the purchasing process and tracking of purchases is possible (see at least Abstract, Col 2, lines 44 – 54, Col 7, lines 48 – 59, Col 8, lines 28 – 57, Col 9, lines 25 – 29 and Figures 2 – 5 and 14). Rosenberg (an automated inventory system) in the same area of online searching and ordering of items teaches a system for storing and searching on-site inventory information (see at least Abstract and Figure 16B). Therefore, one of ordinary skill in the art at the time of the invention would have been motivated to extend the system of

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Barnes with a system for storing and searching on-site inventory information - to ensure that unneeded items are not purchased. In this manner, the company can reduce both time and paperwork associated with searching for and purchasing of non-production items. Thereby, the for-profit company will save money and increase profits as well as ensuring that non-required items are not inadvertently ordered.

In response to appellant's remark's at page 10 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner has not relied upon Appellant's own teachings to provide motivation for combining the teachings of Barnes and Rosenberg. In that regard, the problem to be solved is the need for an automated requisitioning and inventory system. Barnes as noted above discloses and teaches an automated acquisition system with the capability for the vendors to download as well as update their catalogs on an internal server (ESAC). Moreover, Barnes discloses and teaches the system capability to search these catalogs as well as including integration of legacy systems such as inventory. In turn, Rosenberg discloses and teaches an automated system for searching and ordering of on-site inventory items. Therefore and as noted above, one of ordinary

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skill in the art at the time of the invention would have been motivated to combine the system of Barnes with the system of Rosenberg to have enabled a system for an automated acquisition and inventory system.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

RER

August 20, 2004


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